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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,047	10/11/2001	Benny B. Johansen	RXSD 1020-1	1000

22470 7590 12/28/2005

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EXAMINER	
TRAN, CON P	

ART UNIT	PAPER NUMBER
2644	

DATE MAILED: 12/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/975,047	JOHANSEN ET AL.	
	Examiner	Art Unit	
	Con P. Tran	2644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1-3, 5-13, 15-24** are rejected under 35 U.S.C. 102(e) as being anticipated by Horn U.S. Patent 6,379,314 (cited by Applicants).

Regarding **claims 1 and 12**, Horn teaches a method of testing the hearing of a user utilizing a computer system, the computer system including a computer and a speaker, the computer operable to output an electrical signal to the speaker, the speaker operable to convert the electrical signal into a stimulus (see Abstract; col. 3, lines 14-25), the method comprising:

a) downloading a computer program (i.e., for hearing test including system compatibility) from a server to the computer (internet; col. 4, lines 27-30);

b) executing the computer program on the computer (i.e., the computer system initiates a test program), the execution of the computer program generating an

audio stream (i.e., by electronic data, Abstract; data instructs user's computer to generate a sequence of pure tone, i.e., a TOV "raw data" is created for each sound card then sound card generates audio stream for speakers or earphones, col. 4, lines 45-67; col. 6, lines 23-33);

c) based upon the audio stream (generated by sound card of PC system, col. 4, lines 45-67; col. 6, lines 23-33), generating a stimulus (e.g., sound; col. 6, lines 34-50); and

d) receiving an input from the user that indicates if the user heard the stimulus (see Abstract; col. 3, lines 14-25; col. 6, lines 34-50).

Claim 12 is met since computer program (i.e., for hearing test including system compatibility) causing generation of a stimulus (i.e., sound, tones) by supplying the audio stream (generated by sound card of user's computer) to the speaker (col. 4, lines 45-67).

Regarding **claim 2**, Horn further teaches wherein the computer program includes an audio parameter and wherein the audio stream is generated based upon the audio parameter (table of value; col. 4, lines 37-45).

Regarding **claims 3 and 13**, Horn further teaches wherein the act of downloading the computer program includes transferring the computer program from the server to the computer via the Internet (see Abstract; col. 3, lines 14-25).

Regarding **claims 5 and 15**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates at least one frequency of the stimulus (250-12,00Hz; Abstract; col. 3, lines 14-25; col. 4, lines 37-45).

Regarding **claims 6 and 16**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates at least one amplitude of the stimulus (different amplitudes, i.e. dB; Abstract; col. 3, lines 14-25).

Regarding **claims 7 and 17**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates at least one type of the stimulus (white noise, col. 5, lines 8-10; pure tone; col. 5, lines 21-27).

Regarding **claim 8**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates that two stimulus types should be combined to generate the stimulus (pure tone; col. 5, lines 21-27).

Regarding **claim 9**, Horn further teaches wherein the act of downloading the program from a server includes downloading an audio parameter that indicates that the

program should determine which stimulus should be presented in the test (table of value; col. 7, line 58 – col. 8, line 9).

Regarding **claim 10**, Horn further teaches wherein the act of generating a stimulus includes generating a stimulus within a user-defined frequency range (base line; col. 4, lines 34-45).

Regarding **claims 11 and 18**, Horn further teaches the method of claim 1, further including a) sending first data to the server; b) qualifying the hearing of the user; and c) sending second data to the computer (see Abstract; col. 3, lines 14-25)..

Regarding **claims 19-24**, these claims merely specifies a program necessary for operating (performing) to method claim of claims 1-2, and 6-11 and is therefore interpreted and rejected for the same reasons. It should be noted that claim 19 including limitations of claim 11.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 4 and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Horn U.S. Patent 6,379,314 (cited by Applicants) in view of Admitted Prior Art (hereinafter, "APA").

Regarding **claims 4 and 14,** Horn teaches the method of claim 1. Horn disclose transferring a computer program over Internet (col. 3, lines 14-19). However, Horn does not explicitly disclose, wherein the act of downloading the computer program includes transferring the computer program from the server to the computer via an email.

APA discloses as is well known, computer programs may be attached to emails that can be easily distributed (i.e., transferred) over the Internet (i.e., "As is well known, computer programs may be attached to emails . . ."[0013], page 4).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer the program as disclosed by Horn via email as taught by Admission in order to easily distribute the program.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. **Claims 1, and 3-4** are provisionally rejected under the judicially created doctrine of obviousness-type double patenting over **claims 1-3** of copending Application No. 09/996161 in view of Horn (U.S. 6,379,314). This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The copending application claims a hearing test computer program downloaded through the Internet, via email; and generating a stimulus. The copending application does not claim generating an audio stream; based upon the audio stream, generating stimulus. However, Horn discloses a method and computer program for testing the hearing of a user. The program is downloaded through the Internet; generating audio stream (i.e., by electronic data, Abstract; data instructs user's computer to generate a sequence of pure tone, i.e., a TOV "raw data" is created for each sound card then sound card generates audio stream for speakers or earphones, col. 4, lines 45-67; col. 6, lines 23-33)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and computer program of the copending application with the audio stream of Horn to generate a stimulus for purpose of providing a simple, low-cost hearing test over the Internet (col. 3, lines 35-36).

Response to Arguments

7. With respect to objection to claim 12, the claim has been amended. Accordingly, the objection is removed.

8. With respect to rejection of claims 1-3, and 4 for obviousness-type double patenting over Application No. 09/975,581, Applicants' argument is persuasive. Accordingly, the rejection is withdrawn.

9. Regarding Applicants' argument that Horn is silent as to the generation of the audio stream used to generate the sound, Examiner respectfully disagrees. As presented above in the Office Action, Horn using sound card to generate audio stream (col. 4, lines 45-67).

10. Regarding Applicants' argument that Examiner did not refer to any specific text that constitutes such admission, the text is provided above in the Office Action.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Con P. Tran whose telephone number is (571) 272-7532. The examiner can normally be reached on M - F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Vivian C. Chin can be reached on (571) 272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

cpt CPJ
December 20, 2005

XU MEI
PRIMARY EXAMINER